



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/026,532 | 12/27/2001 | Ryouichirou Nagamine | PNDF-01197 | 9433 |

21254 7590 09/28/2005

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

BRITT, CYNTHIA H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2133

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,532

Applicant(s)

NAGAMINE ET AL.

Examiner

Cynthia Britt

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-14 are presented for examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 16, 2005 has been entered.

Response to Amendment

Applicant's arguments, see pages 18-21, filed August 18, 2005, with respect to claims 1-14 have been fully considered and are persuasive. The 35 USC 112 second paragraph rejections of claims 1-14 have been withdrawn. The 35 U.S.C. 102 e rejections have also been overcome by these amendments and also the interview held on August 15 2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claim 1, line 12 recites "...the test pattern measures an alternating current characteristic..." The specification states that the test pattern is *used for the purpose of measuring the ac characteristic of the circuit*, but states that the measurement is taken at the output terminal. Therefore, it is unlikely that the test pattern actually measures the ac characteristic. The specification discusses observation of the output signal on an LSI tester for judgment, and in part "The AC characteristic of the input terminal IN I can be determined from the delay time of the data signal relative to the clock signal on the basis of the aforementioned judgment (page 12 lines 5-7)." Page 11 line 15 through page 12 line 17 describes this in more detail.

This same issue arises in each of the independent claims as follows:

Claim 2, line 12

Claim 3, line 12

Claim 4, lines 13-14

Claim 5, lines 13-14

Art Unit: 2133

Claim 6, lines 14-15 (lines 31-33 specify “measuring the alternating current characteristic of the functional input terminal of said logical integrated circuit by inspecting an output of the scan output terminal of said logical integrated circuit.”)

Claim 7, lines 14-15 (also specifies “measuring the alternating current characteristic of the functional input terminal of said logical integrated circuit by inspecting an output of the scan output terminal of said logical integrated circuit.” Lines 29-31)

Claim 8, line 10

Claim 9, line 10

Claim 10, line 10

Claim 11, lines 11-12 (also specifies “measuring the alternating current characteristic of the functional input terminal of said logical integrated circuit by inspecting an output of the scan output terminal of said logical integrated circuit.” Lines 19-21)

Claim 12, lines 11-12 (also specifies “measuring the alternating current characteristic of the functional input terminal of said logical integrated circuit by inspecting an output of the scan output terminal of said logical integrated circuit.” Lines 19-21)

Claim 13, lines 12-13 (also specifies “measuring the alternating current characteristic of the functional input terminal of said logical integrated circuit by inspecting an output of the scan output terminal of said logical integrated circuit.” Lines 29-31)

Claim 14, line 12 (also specifies “measuring the alternating current characteristic of the functional input terminal of said logical integrated circuit by inspecting an output of the scan output terminal of said logical integrated circuit.” Lines 27-29)

Allowable Subject Matter

The examiner suggests wording in the claims that would indicate, "*the test patterns are used to measure* an alternating current characteristic at the output of the circuit..." This would clear up the lack of enablement issues indicated above. Since, it is not clear that one of ordinary skill in the art at the time of the invention would have made the necessary modifications to the prior art of record to encompass the limitations set forth in the present application and as no prior art has been located which would render the above claims obvious or not novel. After the 35 U.S.C. 112 first paragraph issues have been overcome, claims 1-14 would be allowable over the prior arts of record.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Britt whose telephone number is 571-272-3815. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2133

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cynthia Britt
Examiner
Art Unit 2133